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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

CLEMENT, MICHELLE RENEE

ART UNIT

PAPER NUMBER

3641

DATE MAILED: 10/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/731,684

Applicant(s)

VASEL ET AL.

Examiner

Michelle (Shelley) Clement

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2006.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-25 and 52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-25 and 52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>Assignment History</u> . |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 8/21/06 have been fully considered but they are not persuasive. With regards to applicant's arguments concerning the Knapp reference and applicant's assertion that Knapp does not include an "inhibiting substance", it is noted that any substance that inhibits, restrains, holds back or restricts a target in any manner or that would inhibit a target from escaping can be considered an "inhibiting substance". It is further noted that the substance, contained within the volume of the projectile of Knapp, marks the target thereby *inhibiting* the target from escaping. In regards to applicant's assertion that Knapp does not include "additional stabilizers", it is noted that 1) applicant's arguments are narrower than the present claims and 2) Knapp does disclose "additional stabilizers" that are different than the disclosed "stabilizing fins". Applicant has claimed stabilizing fins and additional stabilizers, since applicant includes the term "additional" with the term stabilizers and has only previously claimed fins as the initial stabilizers, from the claim language the "additional stabilizers" would be additional stabilizing fins. **Furthermore applicant has not specified in the claims or the specification that the "additional stabilizers" are anything other than additional, or extra, stabilizing fins.** It is further noted that anything that stabilizes the flight of the projectile, such as an aerodynamically shaped body or nose can be considered an "additional stabilizer" since applicant has not claimed any specific structure for the "additional stabilizers". Secondly, it is noted that Knapp discloses stabilizer fins (reference 91, 91', 91") and additional stabilizers (references 92, 92', See figure 16), the additional stabilizers are different and additional to the

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stabilizer fins and add additional/more stabilization to the fins (91, 91', 91'') than the fins by themselves.

2. In response to applicant's statement indicating common ownership of the pending application and the Vasel patent (US Patent # 6,543,365) to JACOR TACTICAL SYSTEMS, INC., this is not persuasive. Upon an initial assignment search of the pending application, as well as for the corresponding provisional application 60/446657, no assignment information was found for JACOR TACTICAL SYSTEMS, INC. at the time the invention was made.

"a patent applicant urging that subject matter is disqualified as prior art under 35 U.S.C. 103(c), would have the burden of establishing that it was commonly owned at the time the claimed invention was made. The patentee in litigation would likewise properly bear the same burden placed upon the applicant before the U.S. Patent and Trademark Office. To place the burden upon the patent examiner or the defendant in litigation would not be appropriate since evidence as to common ownership at the time the claimed invention was made might not be available to the patent examiner or the defendant in litigation, but such evidence, if it exists, should be readily available to the patent applicant or the patentee." (See M.P.E.P. 706.02 (I)(2)).

3. In response to applicant's arguments that the sealing disc of Carbone is not equivalent to the propulsion block of the present application, it is noted that the term "propulsion block" is not an art recognized term; therefore the structure and purpose of the elements must be compared to determine equivalence. Applicant's claimed propulsion block is configured for or adapted to "evenly distribute the propulsion force to the projectile" it has been held that the recitation that an element is "adapted to " perform a function and is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. Applicant has disclosed that the propulsion block achieves the desired function by having a diameter that is designed to create a seal between the propulsion block and the shell and the figures show the propulsion block located between the projectile and the primer. The disc of Carbone is located between the projectile and the primer and has a diameter designed to create a seal between the

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disc and the shell in order to prevent gas generated by the ignition of the powder from leaking along the inner walls of the cartridge. By preventing leaking the gases are allowed to build up thereby allowing a propulsion force to build up and be evenly distributed behind the seal rather than unevenly distributed by leaking around the seal, the gases are evenly distributed for the time before the seal ruptures. Since the present claims do not require a minimum time that the propulsion force be maintained behind the propulsion block, it is irrelevant that the seal of Carbone ruptures at some point. By allowing the propulsion force to build up behind the disc the projectile will be expelled with more force.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 16 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Knapp (US Patent # 4,448,106): Knapp discloses a projectile system for use in delivering a substance to a target, comprising a projectile comprising a first part that is generally non-frangible nose section (reference 25), a second part that is at least partially hollow (reference 50), wherein the second part is secured with the first part to seal the hollow portion defining a volume, wherein the projectile is non-spherical, an inhibiting substance contained within the volume and stabilizing fins (reference 91, 91', 91'') secured with the second part along an exterior of the second part and additional stabilizers (reference 92, 92') positioned on the exterior of the second part.

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6. Claim 52 is rejected under 35 U.S.C. 102(b) as being anticipated by either Riffet et al. (US Patent # 6,209,461) or Blacker (US Patent # 2,112,758). Both Riffet et al. and Blacker individually disclose a projectile system that can be used in delivering a substance to a target, the system comprising a projectile comprising, a first part, a second part that is at least partially hollow and further comprises a tapered tongue, wherein the second part is secured with the first part to seal the hollow portion defining a volume, wherein the projectile is non-spherical, an inhibiting substance contained within the volume, and a third part comprising stabilizing fins secured along an exterior of the second part and a receiving port that mates with the tapered tongue and wherein the inhibiting substance is dispersed into a cloud upon impact of the projectile with a target.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 13-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vassel et al. (US Patent # 6,543,365) and Carbone (US Patent # 5,361,700). Vassel et al. discloses the claimed projectile system for use in delivering a substance to a target comprising a projectile comprising a first part, a second part that is at least partially hollow wherein the second part is secured with the first part to seal the hollow portion defining a volume, wherein the projectile is non-spherical (Figures 16-19); an inhibiting substance (reference 1704) contained within the volume; stabilizing fins (reference 1802) (figure 20A) secured with the second part along an

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exterior of the second part and additional stabilizers (reference 22) positioned on the exterior of the second part; wherein the inhibiting substance is dispersed into a cloud upon impact of the projectile with a target (Figures 23 and 24). Wherein the first part is at least partially hollow where the hollow portion of the first part cooperates with the hollow portion of the second part defining a volume such that the inhibiting substance is contained within the volume (Figure 17A). Wherein the second part tapers to a smaller diameter away from the first part, and the second part has a length that is greater than a width of the first part, further comprising additional stabilizers positioned on the exterior of the second part (Figure 19). Further comprising a shell, an ignitable substance positioned within the shell wherein the ignitable substance propels the projectile from the shell upon ignition of the ignitable substance and a propulsion block positioned within the shell wherein the projectile is positioned within the shell adjacent the wadding and diaphragms (i.e. propulsion block) (references 308 and 305) and the ignitable substance includes primer positioned within the shell such that the primer when ignited propels the propulsion block which forces the projectile from the shell (Figure 39B and columns 49 and 50). The diaphragms may be formed of various materials such as plastic or polymer. The inhibiting substance includes capsaicin. The system further comprising a cartridge coupled with the second part wherein the cartridge includes means for launching the projectile. The system further comprising a plurality of projectiles and a means for launching the plurality of projectiles which launches at least a sub-set of the plurality of projectiles within a limited time to contact a target along a path across the target (columns 12 and 13). It is inherent that the first part could be reused if it could be found and the degree of frangibility is dependent on the target hit. Although Vassel et al. does not expressly disclose the projectile wherein the wadding and

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diaphragms are configured to maintain substantially all of a propulsion force behind the propulsion block and to evenly distribute the propulsion force to the projectile, Carbone does. Carbone teaches a projectile containing paint, or other fluid, within a shotgun cartridge. The cartridge comprising powder charge and a gas-sealing disc (reference 9) to prevent gas generated by the ignition of the powder from passing up or along the inner walls of the cartridge as is well known in shot gun cartridges. Carbone and Vasel et al. are analogous art because they are from the same field of endeavor: non-lethal projectile systems. Therefor, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the gas sealing disc as taught by Carbone with the projectile system as taught by Vasel et al. The suggestion/motivation for doing so would have been to obtain a projectile that could have been fired using standard shot gun cartridges as is well known in the art.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle (Shelley) Clement whose telephone number is 571.272.6884. The examiner can normally be reached on Monday thru Thursday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on 571.272.6873. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


MICHELLE CLEMENT
PRIMARY EXAMINER